

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: White et al.

GROUP ART UNIT: 3731

SERIAL NO.: 10/733,292

CONFIRMATION NO.: 2518

EXAMINER: Michael Thaler

FILED: 12/12/2003

FOR: Intraluminal Graft

**37 CFR 41.41 REPLY BRIEF**

BOX STOP APPEAL BRIEF - PATENTS

COMMISSIONER FOR PATENTS

P.O. BOX 1450

ALEXANDRIA, VA 22313-1450

Sir:

Pursuant to 37 CFR 41.41, appellant replies to the SECOND examiner's answer mailed 9/21/ 2006.

**NOTE:** The arguments in the second examiner's answer mailed 9/21/2006 is word for word identical to the arguments in the first examiners answer mailed 2/17/2006. Accordingly, the appellants reply arguments below are word for word identical to the appellants reply arguments submitted in the appellants reply brief filed 4/17/2006 in response to the first examiner's answer.

37 CFR 41.37(c)(1)(vii) Argument

**A. The Rejection of Claims 12-36**

In the examiner's answer mailed on 02/17/2006 at pages 6 lines 13-16, the examiner states that:

"It has been demonstrated that the Piplani et al. prosthesis is inherently capable of being placed in a vessel in the claimed location."

In reply, the appellant submits that has not been demonstrated.

At page 6 line 16 through page 7 line 4 the examiner states that:

"In response to the argument on pages 9-10 of the brief, although the Piplani et al. indicates that the graft should not be located past the renal arteries since such a placement would occlude the renal arteries (col. 11, lines 44-48), Piplani et al. does not indicate that the wires structure (126) should not be so located. In any event, it is not the examiner's position that it would have been obvious to so locate the Piplani et al. prosthesis. Rather, it is the examiner's position that the Piplani et al. prosthesis, with no structural modification, is inherently capable of being located as claimed as further explained below."

In reply, the examiner admits that Piplani does not disclose or suggest wire structure located across the lumen of the renal arteries. The appellant points out that nowhere does Piplani indicate that wire structures 126 can be positioned to occlude the renal arteries. Given that, what artery or lumen does the examiner rely upon for the Piplani device to inherently be capable of occluding?

At page 7 line 5 through page 8 line 13 the examiner states that:

“The apices of applicant's invention are apparently considered to be the entire portions of the wire structure 17 that extend beyond the end of the graft rather than the extreme, peaks of the wire (since they are defined as extending across a lumen of the second vessel). Similarly, the apices of the Piplani et al. wire structure 126 may be considered to be the entire portions of the wire 126 that extend beyond the end of the graft. Note that the diameter of the Piplani et al. wire structure 126 is a relatively small 0.254 to 0.381 mm (Note col. 5, lines 35-58 which indicates that the wire structure 126 is constructed in a manner similar to that as described in U.S. Patent 5,275,622 which, in turn, discloses in col. 9, lines 28-34 a wire diameter of 0.01 to 0.015 inches which is 0.254 to 0.381 mm.) while the diameter of the wire structure 17 of appellant's invention is a relatively large 0.3 to 0.4 mm (page 9, lines 22-23 of appellant's specification). Thus, the Piplani et al. wire structure 126 is inherently sufficiently small in diameter so as not to occlude the lumen of the second vessel, as structure of appellant's invention. Further, the Piplani et al. wire structure 126 extends beyond the end of the graft by a relative large distance of 1 cm (i.e. the distance between planes 141 and 142 as indicated in col. 9, lines 39-46 of U.S. Patent 5,275,622) while the wire structure 17 of appellant's invention extends beyond the end of the graft a relatively small distance of less than 6 mm (noting that the entire amplitude of, the wire is about 6mm as indicated on page 10, lines 2-6 of appellant's specification). Thus, the Piplani et al. wire structure 126 inherently extends sufficiently far beyond the end of the graft to extend completely across a lumen of the second vessel, as claimed, since it extends farther beyond the end of the graft than appellant's invention.”

In reply, the examiner has not established (1) that Piplani's wires are long enough for a graft and (2) have dimensions, such that the graft can be positioned such that its wires extend across a lumen of an artery.

The examiner improperly relies in the answer on USP 5,275,622 (page 8 lines 1-12) since

that reference was not a part of any rejection in the office action. Therefore, the panel should dismiss all argument in the answer relying thereupon. However, since the examiner raised that reference, the appellant points out that it shows (Figs. 10, 11) the same type of spring structure as in Piplani, and it also refers to the non-coiled portions of that structure as “vees” (col. 8 lines 49-54 in USP 5,275,622) indicating that “vees” are recognized in the art and therefore not what appellant’s claims reciting “sinusoidal” mean.

At page 8 lines 14-19 the examiner states that:

“Appellant argues on page 10 of the brief that the Piplani wire, if located as the examiner proposes, would result in some hooks not pressing against tissue. This argument is incorrect since the Piplani hooks would press against the tissue on the first vessel which is just beyond its intersection with the second vessel.”

In reply, this argument makes no sense to the appellant. If Piplani’s hooks face an aperture of a lumen, they press against no tissue.

At page 8 line 20 through page 9 line 8 the examiner states that:

“Appellant argues on pages 11-12 of the brief that the wire structure 126 of Piplani et al. is not generally sinusoidal or generally zig-zag shaped. This argument is incorrect. The structure shown in figure 8 of Piplani et al. has the same basic shape as wire structure 126 (col. 7, lines 25-28). This structure is clearly generally zig-zag shaped since it undulates up and down along its circumference. The coils 203 and hooks 211 take up only a small portion of the structure and thus do not prevent the structure from being generally zig-zag shaped. Similarly, the structure is clearly generally sinusoidal since, like a sine wave, it even has rounded curves (at 203) at the apices of the wave shape.”

In reply, the panel should compare Piplani Fig. 8 to Fig. 6 in the application and note that

Piplani refers to its V-shaped portions of its coiled spring structures 131 (See Fig. 4) as “vees 131” (see col. 5 line 46-50) and element 201 (see Fig. 8) as “vees 201” (see col. 7 line 29), which means “V-shaped”. In contrast, our specification shows sinusoidal shaped structures (see Fig. 6 in the application) and distinguishes between sinusoidal and zig-zag (aka “v”) shapes (see page 2 numbered lines 3-10).

At page 9 lines 9-14 the examiner states that:

“Appellant alleges on page 12 of the brief that the examiner fails to assert that Piplani discloses any additional wires not at an end of the prosthesis, as defined by claims 31-36. This allegation is incorrect since the final rejection clearly refers to additional wires (the lengths of platinum wires described in col. 5, lines 23-27 of Piplani).”

In reply, the appellant admits that Piplani column 5 lines 25-27 discloses lengths of platinum wire.

In light of the foregoing additional arguments, appellant respectfully submits that the rejections of claims 12-36 are improper and should be reversed.

Respectfully Submitted,

9/25/2006

DATE

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